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Guy Nathan

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

MURDOUGH, JOSHUA A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/661,811	Applicant(s) NATHAN ET AL.	
	Examiner JOSHUA MURDOUGH	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43,44,47-54,57-62 and 65-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43,44,47-54,57-62 and 65-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is responsive to Applicants' amendments received 13 January 2010.
2. This action has been assigned paper number 20100422 for reference purposes only.
3. Claims 43, 44, 47-54, 57-62, and 65-79 are pending.
4. Claims 43, 44, 47-54, 57-62, and 65-79 have been examined.
5. This action has been made non-final because the Examiner found better prior art while updating his search.

Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- a. “a first storage location” in at least claim 43;
- b. “a second storage location” in at least claim 43;
- c. “a user interface” in at least claim 43;
- d. “collection of an appropriate fee of number of credits” in at least claim 43;
- e. “encryption level” in at least claim 50;
- f. “a layer of encryption” in at least claim 51;
- g. “predetermined number of bytes” in at least claim 52;
- h. “repository of instances of media” in at least claim 53.

Claim Rejections - 35 USC § 112 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 43, 44, 47-54, 57-62, and 65-79 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

9. Claims 43 and 53 recite “a first storage location” and “a second storage location” as part of “a jukebox device.” As noted above, the specification does not make reference to either “a first storage location” or “a second storage location.” Figure 7 does show IDE controllers (78 and 80) with multiple hard disk drives (82, 84, 86, and 88). However, the IDE controllers and disk drives are part of the local server (22). In Figure 2, the jukebox devices (16) are shown as separate from the local servers (22). Therefore, these disk drives are not shown as part of the jukebox device. The Examiner, upon rereading the specification, could not find any indication that there were multiple storage locations in the jukebox as originally disclosed. In order to provide more relevant prior art, the Examiner has interpreted these claims as being directed toward a jukebox system instead of a jukebox device when applying the prior art.

10. Applicants have contended that the “second storage location” corresponds to the “local server” (Remarks, Page 11, 1st bullet). However, Paragraph [0009] of Applicant’s specification

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states “[i]n other words, the user can first search the local storage on the jukebox for desired songs and then, if desired, search further on the local server for desired songs.” Therefore, according to Applicant's specification, the local server is distinct from the local storage. Because the local server is distinct from the local storage, Applicants' specification does not show adequate support for the local server being a second storage location.

11. Claim 61 also recites “a first storage location” and “a second storage location” and is therefore rejected under the same rationale.

12. Claim 71 recites “at least one storage location.” Because “at least one,” can include a second, claim 71 is rejected under the same rationale as claims 43, 53, and 61.

13. Claims 51 and 69 recite “each instance of media in the second plurality of instances of media is encrypted with a layer of encryption different from the first encryption level.” The Examiner has only been able to find one disclosure of an encryption method. This method includes using a block removed from the media to encrypt the subsequent block ([0011] and [0026]). However, there is no disclosure of a different encryption level.

14. Claim 53 further recites “a central server operably connected to a repository of instances of media.” Applicants have stated that paragraph [0023] shows support for this with “[t]he central server 12 includes a master library of songs (and/or other content).” However, claim 53 recites that the central server is “operably connected to” the repository of instances of media, not that the central server “includes” the repository of instance of media. Because being connected

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and included are different relationships, the claiming of the “central server operably connected to a repository of instances of media” is new matter.

15. Claim 73 recites “a jukebox device...comprising: at least one storage location configured to store instances of media available for playback via the jukebox device, the instances of media being divided into first and second subsets of media.” Applicants' original disclosure states “any one jukebox only stores *a subset* of the complete library of songs maintained by the central server at any one time” [emphasis added] [0005] and “[e]ach of the jukebox devices includes *a subset* of the master library on a local storage device of the jukebox” [emphasis added] [0023]. Therefore, the express disclosure of a single storage location in a jukebox only containing a single subset indicates that a single storage location in a jukebox including multiple subsets was not in Applicants' possession at the time the application was filed.

Claim Rejections - 35 USC § 112 2nd Paragraph

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 50-52, 68-70, and 75-78 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

18. In claims 50, 51, 68, and 69, the phrase “encryption level” is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined.

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First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "encryption level" (as used in the context of these particular claims) is not known to those of ordinary skill in this art.

19. Claims 51 and 69 recite "a layer of encryption different from the first encryption level."

The Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for the phrase "layer of encryption." Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "layer of encryption" (as used in the context of these particular claims) is not known to those of ordinary skill in this art. Because the "layer of encryption" is compared to the "first encryption level," it is the Examiner's position that a "layer of encryption" and an "encryption level" are synonymous. Therefore, because neither "encryption level" nor "layer of encryption" have been defined in the instant specification and their meanings cannot be ascertained from the context of the claims, the metes and bounds of these claims are indefinite.

20. The Examiner acknowledges that there are mutually exclusive interpretations in the art for levels or layers of encryption. See Stefik (US 2005/0086172) Table 2, Schneier (Applied Cryptography) Page 216 "Encrypting Communications Channels," Schneier Page 222 "Driver-Level vs. File-Level Encryption," and Schneier Page 584 "Pretty Good Privacy." Each of these citations is to descriptions of layers or levels of encryption and security. However, Applicants

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have not included any indication which, if any, of these mutually exclusive implementations they are claiming.

21. Claims 75-77 are rejected because they apparatus claims which contain limitations, for which, one of ordinary skill in the art would not know what the corresponding structure is needed to infringe.

i. Claim 75 recites “after at least some instances not included in the first subset of media are searched for instances of media matching the search criteria.” One of ordinary skill in the art would not understand what structure is needed in order to infringe this limitation.

j. Claim 76 recites “the second subset of media is searched.” Again, one of ordinary skill in the art would not know what, if any, structure required to perform the function.

k. Claim 77 recites “the first and second subsets of media are searched.” Similarly, one of ordinary skill in the art would not know if there is any structure required to perform the function.

22. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

23. To overcome these rejections, the Examiner suggests claiming the noted functions in claims 75-77 as computer programs. For example, the use of “programmed to” would make the

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function exist in software, which is considered to be structure. Because the function would exist as part of the structure, there would be no ambiguity as to what structure is needed.

Additionally, this would result in more weight being given to the limitations when applying the prior art.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 43-44, 47-49, 53-54, 57-62, and 65-67, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles (US 5,481,509) in view of Verduin (US 4,667,802).

26. As to claim 43, Knowles shows:

l. A jukebox device **5**, comprising:

m. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media (Figure 4A, step 120) available for playback via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);

n. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the

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selected instance of media on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5) following collection of an appropriate fee or number of credits (Steps 152 and 154),

27. Knowles does not expressly show:

- o. a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.
- p. wherein the first storage location is different from the second storage location.

28. However, Verduin shows a record player **42** which plays audio selections for a first price (Abstract and claim 1) as well as a VCR **54** which plays audio-video selections for a second price (Abstract and claim 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to designate each of the hard disks **52** for different priced media because then the computer could identify the hard disk and charge accordingly instead of having to add metadata to the files or create a lookup table.

29. As to claim 44, Knowles further shows:

- q. the first and second storage locations respectively comprise first and second disk drive devices(Figure 2).

30. As to claim 47, Knowles further shows:

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r. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).

31. As to claim 48, Knowles further shows:

s. the first and second storage locations are updatable independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

32. As to claim 49, Knowles further shows:

t. a selected instance of media from said second plurality of instances of media becomes at least temporarily available on the first storage location (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

33. As to claim 53, Knowles shows:

u. A digital audiovisual distribution network, comprising:

v. a plurality of jukebox devices respectively located at a plurality of locations; and

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- w. a central server **100** operably connected to a repository **112** of instances of media distributable to the jukebox devices via the network (Column 5, lines 51-61);
 - x. wherein each said jukebox device (Figure 2) comprises:
 - y. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);
 - z. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the selected instance of media on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5) following collection of an appropriate fee or number of credits (Steps 152 and 154),
34. Knowles does not expressly show:
- aa. a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.
 - bb. wherein the first storage location is different from the second storage location.
35. However, Verduin shows a record player **42** which plays audio selections for a first price (Abstract and claim 1) as well as a VCR **54** which plays audio-video selections for a second price (Abstract and claim 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to designate each of the hard disks **52** for different priced media because then the computer could identify the hard

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disk and charge accordingly instead of having to add metadata to the files or create a lookup table.

36. As to claim 54, Knowles further shows:

cc. the first and second storage locations respectively comprise first and second disk drive devices (top/middle 52 in Figure 2).

37. As to claim 57, Knowles further shows:

dd. the second plurality of instances of media substantially mirrors the repository of instances of media operably connected to the central server (Column 5, lines 21-33).

38. As to claim 58, Knowles further shows:

ee. the first and second storage locations are updatable via the network independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

39. As to claim 59, Knowles further shows:

ff. an instance of media from said second plurality of instances of media selected for playback is at least temporarily available on the first storage location (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of

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“Video[s]” 202; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

40. As to claim 60, Knowles further shows:

gg. an instance of media stored in the repository of the central server, subsequent to user request, is downloadable to a storage location of one said jukebox device (Column 5, lines 21-33) for a third fee or number of credits (as evidenced by Figure 4A, step 136), the third fee or number of credits being higher than the second fee or number of credits (multiple prices are disclosed, if there are 3 prices, one is going to be the highest, one will be the middle, and one will be the lowest).

41. As to claim 61, Knowles shows:

hh. A method of operating a jukebox device, comprising:

ii. providing a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);

jj. receiving, via a user interface provided to the jukebox device (Figure 5, element 200), user input corresponding to a selection of an instance of media available for playback from the first and second pluralities of instances of media for playback on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5)

42. Knowles does not expressly show:

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kk. providing a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.

ll. wherein the first storage location is different from the second storage location.

43. However, Verduin shows a record player **42** which plays audio selections for a first price (Abstract and claim 1) as well as a VCR **54** which plays audio-video selections for a second price (Abstract and claim 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to designate each of the hard disks **52** for different priced media because then the computer could identify the hard disk and charge accordingly instead of having to add metadata to the files or create a lookup table.

44. As to claim 62, Knowles further shows:

mm. the first and second storage locations respectively comprise first and second disk drive devices (Id.).

45. As to claim 65, Knowles further shows:

nn. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).

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46. As to claim 66, Knowles further shows:
- oo. updating the first and second storage locations independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).
47. As to claim 67, Knowles further shows:
- pp. making available on the first storage location, at least temporarily, a selected instance of media from said second plurality of instances of media (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).
48. Claims 71-79 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles in view of Shneidlman (US 2006/0038794).
49. As to claims 71, 74, 76, and 77, Knowles shows:
- qq. A jukebox device **5** configured to playback an instance of media selected by a user ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5), comprising:
 - rr. at least one storage location **52** configured to store instances of media available for playback via the jukebox device (Figure 4A, step 120), the instances of media being

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divided into first and second subsets of media, the first and second subsets of media being different from one another (Figure 4A, steps 120 and 124); and

ss. a user interface provided to the jukebox device configured to receive input from a user corresponding to a selection of an instance of media from the instances of media in order to initiate playback of the selected instance of media on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5),

tt. the user interface comprising a first display configured to receive input from a user for the selection of the instance of media for playback from the first subset of media **18** for a first fee or number of credits (as evidenced by Figure 4A, step 136), and

uu. the display configured to receive input from a user for the selection of the instance of media for playback from at least the second subset of media (Figure 4A, step 120) for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of credits being greater than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower), and

vv. second display screen configured to enable a user to select the instance of media for playback (Figure 5, element 220).

50. Knowles does not expressly show that the list of media is searchable.

51. Shneidman shows “multi-searchable jukebox type applications” (Paragraph [0063]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to include a search, as taught by

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Shneidman, in order to allow users to access the system and provide them with an easier method of finding and accessing the media.

52. As to claim 72, Knowles further shows:

ww. the first display screen includes a list of artists for each said instance of media in the first subset of media (“Touch here to sort by title or artist” Figure 5).

53. Knowles in view of Shneidman teaches a list of artists being displayed on a jukebox.

However, it does not expressly teach the specific data recited in claim 73 (the album art).

Nevertheless, the difference(s) are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements.

The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106.

54. As to claim 75, Knowles further shows

xx. the second display is configured to display search results **220** after at least some instances of media not included in the first subset of media are searched for instances of media matching the search criteria.

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55. As to claim 78, Knowles further shows:

yy. the search results are selectable by the user in order to initiate playback of the selected search result by the jukebox device for the second fee or number of credits (as evidenced by Figure 4A, step 136).

56. As to claim 79, Knowles further shows:

zz. the first and second displays are each configured to allow a user to supply an additional fee or number of credits in order to make the selected instance of media play immediately after a currently playing instance of media (through element 20).

57. Claims 50, 51, 68, and 69 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles and Verduin further in view of Bowman-Amuah (US 6,289,382).

58. The Knowles/Veerduin combination shows as described above in regards to claims 43 and 61 but does not show the encryption of the media as claimed in these claims.

59. However, Bowman-Amuah shows the encryption of the media in a jukebox system (Column 90, lines 25-37) by use of different mechanisms (Columns 81-82, lines 55-19).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to encrypt the media as shown by Bowman-Amuah in order to prevent unwanted access to the media.

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60. Claims 52 and 70 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles and Bowman-Amuah as applied to claims 51 and 69 above, and further in view of Dunning (US 7,024,485).

61. The Knowles/Verduin/Bowman-Amuah combination discloses as discussed above, but does not expressly disclose:

aaa. each instance of media in the second plurality of instances of media is missing a predetermined number of bytes, said missing bytes being stored in separate respective locations and being at least temporarily insertable into the respective instances of media to enable playback by the jukebox device.

62. However, Dunning shows a jukebox (Figure 2, 103) that splits the content file (Figure 3A, 2714) and only keeps a portion of it (Figure 3A, 2718). When the complete file is requested, the jukebox receives the other portion of the file (Figure 3C, 2734) and combines it with the part stored on the jukebox (Figure 3C, 2738). It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Knowles to include the divided storage of Dunning for reasons including, preventing a complete copy of the file from residing on the jukebox where it could be copied (Dunning, Column 6, lines 24-25).

Claim Interpretation

63. The Examiner hereby adopts the following interpretations under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his

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interpretation of the claims.¹ Additionally, these interpretations are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.

Finally, the following list is not intended to be exhaustive in any way:

bbb. ***Connected***: “joined or linked together.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

ccc. ***Include***: “to take in or comprise as a part of a whole.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

64. Applicant's arguments filed 13 January 2010 have been fully considered but they are not persuasive.

65. Applicants argue:

66. “It appears that the Office Action employs an overly formalistic, hyper-technical, and improperly rigid view of what is required by 37 C.F.R. § 1.75(d)(1) and MPEP 608.01(o). MPEP 608.01(o) begins by stating that ‘[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import...’” (Remarks, Page 10, Paragraph 3).

67. Examiner's response:

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

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68. First, the Examiner notes that the USPTO's Board of Patent Appeal and Interferences ("Board") has recently recognized the lack of antecedent basis of claim terms in the original specification as a "significant problem." See 73 Fed. Reg. 32944 (June 10, 2008) (noting that "[o]ne significant problem faced by the Board under Rule 41.37(c)(1)(v) occurs when the language of a claim does not have direct antecedent language in the specification.").

69. Second, the Examiner notes that patent examiners have no authority to waive the provisions of a rule. See *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987) noting the examiners have no authority to waive 37 C.F.R. §1.111(b).

70. Third, MPEP § 608.01(o) states:

Note that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner's amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see 37 CFR 1.75(d)(1). If the examiner determines that the claims presented late in prosecution do not comply with 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced. The specification should be objected to if it does not provide proper antecedent basis for the claims by using form paragraph 7.44.

71. Because the lack of antecedent basis is currently recognized by the USPTO as a significant problem, because the Examiner has no authority to waive the provisions of a rule, and because the MPEP expressly states that an examiner is to object to the specification when terms or phrases in the claims do not find clear support or antecedent basis in the description, the Examiner concludes that, in accordance with 37 C.F.R. § 1.75(d), an amendment of the specification (or other appropriate correction of the above noted objections to the specification) is still required.

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72. Applicants argue:

73. “Notably, literal or "in haec verba" support is not required by 37 C.F.R. § 1.75(d)(1) or MPEP 608.01(o). Quite the contrary, the sole requirement is that the meanings of claim terms be apparent from the specification and/or figures. Here, one of ordinary skill in the art would be able to understand the meaning of each and every one of the terms found objectionable in the Office Action -- particularly when those terms are read in the context of the surrounding claim language” (Remarks, Page 10, Paragraph 3).

74. Examiner's response:

75. The Examiner respectfully disagrees. The knowledge and understanding of one of ordinary skill in the art is not pertinent to the issue of antecedent basis. The understanding of one of ordinary skill in the art pertains to rejections under 35 U.S.C. § 112 1st paragraph for written description. The Examiner would agree that in haec verba support is not needed to comply with 112 1st paragraph. However, 112 1st paragraph is a separate issue. See MPEP § 1302.01, especially the paragraph beginning “[t]here should be clear support or antecedent basis in the specification for the *terminology* used in the claims” [Emphasis added].

76. Applicants argue:

77. “Claim 75 describes the structure of the second display screen in terms of function, e.g., by describing the time at which it is configured to display certain results. One skilled in the art would not find this to be a purely functional limitation. Moreover, one skilled in the art would be

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able to determine whether the second display screen displays the appropriate information at the appropriate time. Thus, there is nothing inherently wrong with claim 75” (Remarks, Page 14, Partial paragraph).

78. Examiner's response:

79. Applicants state that the structure of claim 75 is described by its function. However, Applicants make no indication as to what the structure is. The Examiner respectfully notes that a screen displaying something at a particular time is a function.

80. Applicants argue:

81. “[T]he allegation that providing a local server would "give the user access to a larger selection of songs" is incorrect. As described in Applicant's specification, providing a local server generally only gives a user quicker access to a subset of instances of media. A local server in exemplary embodiments of Applicant's invention, by definition, cannot provide more songs over and above those included in the master list on the central server. In other words, "quicker" access is not the same as "more" access” (Remarks, Page 16, Paragraph 1).

82. Examiner's response:

83. The Examiner, was not relying on Applicant's particular reasoning for combining the elements. Doing so, might indicate improper hindsight. However, the Examiner's reasoning was that if more storage space is available, such as by adding a server, there could be more songs stored and available for playback on the jukebox device.

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84. Applicants argue:

85. “Despite the Office Action's admissions regarding the deficiencies of Knowles regarding claims 43, 53, and 61, the Office Action curiously does not make similar admissions in the context of claim 71” (Remarks, Page 17, Paragraph 3).

86. Examiner's response:

87. The Examiner respectfully notes that claim 71 does not require the subsets of media to be stored on different storage devices.

88. Applicants argue:

89. “As previously explained at length and as now admitted in the context of certain other claims, however, Knowles simply does not teach price differentiation of any kind” (Remarks, Page 17, Paragraph 3)

90. Examiner's response:

91. The Examiner never stated that Knowles does not teach price differentiation. The Examiner stated instead that the limitations:

- ddd. a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits; and
- eee. wherein the first storage location is different from the second storage location.

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were not shown by Knowles. Knowles teaches separate disk drives (Figure 2) and price differentiation (Figure 4A, 136). Knowles does not teach that each disk drive holds only media which corresponds to a particular price.

92. Applicants argue:

93. “It appears that the Office Action has ignored this claim language because of the appearance of the word "enable." See pages 21-22 and 24-26 of the Office Action” (Remarks, Page 17, Paragraph 4).

94. Examiner's response:

95. The Examiner has reread the previous action pages 21-22 and 24-26, but was unable to find any statement that particular limitations were “ignored.” The fact that the language was addressed by the Examiner shows that it was not ignored but instead was considered. The Examiner made the point about the use of “enable” to point out the potential problems with the term. The Examiner further notes that art was applied to the limitations containing the term "enable" as can be seen in Paragraph 48 of Paper 20091007 for example. Applicants' amendments to remove the term "enable" are noted. It is the Examiner's position that these amendments remove issues that could have been problematic for Applicants at a later time.

Conclusion

96. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a

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formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does *not* constitute a formal requirement mandated by the Examiner.

fff. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112 1st paragraph.

ggg. Independent of the requirements under 35 U.S.C. § 112 1st paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does *not* have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this

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matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

97. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

98. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

99. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621